

100



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,877	08/02/2001	Jerry Y. Jonn	104226.01	4857

25944 7590 04/19/2004

OLIFF & BERRIDGE, PLC
 P.O. BOX 19928
 ALEXANDRIA, VA 22320

EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/919,877

Applicant(s)

JONN ET AL.

Examiner

Frank I Choi

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.


Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____




JOHN PAK
PRIMARY EXAMINER
GROUP 1600

Continuation of 5. does NOT place the application in condition for allowance because: Examiner has duly considered Applicant's arguments but deems them unpersuasive for the reasons of record and the further reasons below. Applicant traverses the restriction requirement because the method of Group II include all of the limitations of Group I and thus must be rejoined upon allowance of the claims of Group I. This is incorrect all of the methods claims of Group II do not contain all the limitations of Group I in that Claim 18 and claims dependent thereon mention nothing of combining two different cyanoacrylates or absorption rates and Claim 20 and claims dependent thereon do not indicate that the first monomer must be absorbable. In any case, the claims of Group I are not allowable. As indicated in the prior Office Action, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As admitted by Applicant, the disclosure in Clark encompassess alkyl ester cyanoacrylates. The fact that Clark teaches preferred embodiments does not teach away from using alkyl ester cyanoacrylates. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 69 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Applicant argues that Clark does not teach the combination of different monomers. However, Clark does teach the combination of different monomers (See Clark, Claim 10). Applicant again applies each of Kronenthal, Banitt and Collins singly with Clark to argue against obviousness, however, as indicated above this is impermissible. There is no requirement that Kronenthal, Banitt and Collins specifically disclose the combination of different monomers. Clark discloses the combination of different monomers which in view of Hammerslag's teaching as to absorption rates and combining of compounds to adjust biodegradation rates, would motivate one to modify the prior art with the expectation that using alkyl ester cyanoacrylates in combination with different monomers have different absorption rates to arrive at the desired absorption rate while minimizing toxicities. Applicant argues that Hammerslag teaches away from the claimed invention because it discloses cross-linking the polymer as a way of adjusting biodegradation rates. However, as indicated above, disclosed examples and preferred embodiments do not teach away from the broad disclosure..